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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,264	12/08/2004	Andrea Mahn	4121-168	9836

7590 04/14/2006

Steven J Hultquist  
 Intellectual Property Technology Law  
 PO Box 14329  
 Research Triangle Park, NC 27709

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DATE MAILED: 04/14/2006

EXAMINER

WORLEY, CATHY KINGDON

ART UNIT

PAPER NUMBER

1638

Please find below and/or attached an Office communication concerning this application or proceeding.

Intellectual Property, Technology Law File # 4121-168 DOCUMENTS FlexTrac <u>ZM</u> SJH <u>M</u> Assigned Atty: <u>SJH</u> (Initials) (Initials)		
ACTION REQ'D	DEADLINE	
1 month	5/14/06	
6 mos.	10/14/06	

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/500,264	MAHN ET AL.	
	Examiner Cathy K. Worley	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-19 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-26,112, claim(s) 1-19, drawn to a method of increasing the content of one or more transgene-coded biomolecules in an organism, the method comprising changing the distribution of ATP and/or ADP in cells of the organism; where in:

- a) the transgene is regulated in a specified manner: constitutive, temporally, locally, inducibly
- b) several transgene biomolecules are expressed in parallel or sequentially
- c) there is a specified host organism: plant or animal
- d) the transgene encodes a specified type of biomolecule: peptide, protein, or nucleic acid
- e) the transgene encodes a specified class of molecule: antibodies, aptamers, receptors, enzymes, growth factors, hormones, specific antigen, antibody molecules, interferons, immunoglobulins, growth hormones, insulin, collagen, plasminogen

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activator, blood factor I, blood factor II, blood factor III, blood factor IV, blood factor V, blood factor VI, blood factor VII, blood factor VIII, blood factor IX, blood factor X, blood factor XI, blood factor XII, histocompatibility antigens, enzymes, tumor marker proteins, viral proteins, ribozymes, single-stranded DNA, double-stranded DNA, single-stranded RNA, or double-stranded RNA

f) subcellular distribution of ATP and/or ADP is either increase or reduced

g) expression of a gene which codes for a protein involved in the subcellular distribution of ATP and/or ADP is either increased or decreased

and

h) the expression of a gene which codes for a protein involved in the subcellular distribution of ATP and/or ADP is constitutive or regulated temporally, locally, or inducibly,

and wherein each of the groups 1-26,112 has a different combination of the items listed in parts a-h.

The inventions listed as Groups 1-26,112 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups 1-26,112 is a method comprising changing the distribution of ATP and/or ADP in the cells of an organism wherein the content of

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one or more transgene-coded biomolecules is increased. However, Tjaden et al. (The Plant Journal (1998) Vol. 16, pp. 531-540) teach altered ATP distribution (see page 533, Table 2) and teach increased content of AATP1 which is a transgene-coded biomolecule (see page 533, figure 2A). Therefore, the technical feature linking the inventions of groups 1-26,112 does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

Accordingly, groups 1-26,112 are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly

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admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy K. Worley whose telephone number is (571) 272-8784. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CKW  
April 3, 2006

CYNTHIA COLLINS  
PRIMARY EXAMINER



4/11/06

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<b>Notice of References Cited</b>		Application/Control No. 10/500,264	Applicant(s)/Patent Under Reexamination MAHN ET AL.	
		Examiner Cathy K. Worley	Art Unit 1638	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages
	U	Tjaden et al. Altered plastidic ATP/ADP-transporter activity influences potato ( <i>Solanum tuberosum L.</i> ) tuber morphology, yield and composition of tuber starch. (1998) <i>The Plant Journal</i> , Vol. 16, pp. 531-540.
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(e).)

Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.